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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------|------------------|
| 09/779,559 | 02/09/2001 | Richard Levy | 01064.0011-06000 | 9094 |
| 7590 | 09/22/2004 | | | EXAMINER |
| The Law Offices of Robert J. Eichelburg Hodafel Building Suite 200 196b Acton Road Annapolis, MD 21403 | | | | GRAY, JILL M |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1774 | |
| | | | DATE MAILED: 09/22/2004 | |

Please find below and/or attached an Office communication concerning this application or proceeding.

S.C.

| | | |
|------------------------------|--------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/779,559 | LEVY, RICHARD |
| | Examiner Jill M. Gray | Art Unit 1774 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 June 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 82-97 and 100-102 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 82-97 and 100-102 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The rejection of claims 57-77 under 35 U.S.C. 103(a) as being unpatentable over Iri et al, 4,711,523 or Freeman, 5,218,011 each in view of Marciano-Agostinelli et al, 5,049,593 is moot in view of applicants' amendment canceling these claims.

Claim Objections

Claims 88 and 100 are objected to because of the following informalities: Claim 88, line 4, the language "with a" is repeated. In claim 100, the preamble is not consistent with that of claims 82-87 and 94. The suggested preamble language is "[t]he substrate". Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 82-97, 100-10~~1~~ are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman 5,218,011 in view of Marciano-Agostinelli et al, 5,049,593 (Marciano-Agostinelli), each as applied in previous Office Actions.

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Freeman teaches an essentially water-free gel composition and method for protecting a substrate such as wires and cables from damage by water, said gel composition comprising a silicone gel matrix and a water absorbent polymer dispersed therein, as required by claims 82, 86-88, 92-93, 96-97 and 100. See abstract. It should

be noted that claims 96 and 97 are product-by-process claims. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227USPQ 964, 966 (Fed. Cir. 1985). In addition, Freeman teaches that the superabsorbent polymer can be based on acrylamides, acrylates, and acrylic acid, as required by claims 84-85 and 90-91. See column 6, lines 20-29. Regarding claim 102, Freeman teaches that the superabsorbent polymer is incorporated into the composition in a concentration ranging from about 5 to about 33.3% by weight. See column 6, lines 60-63. As to claims 83, 89 and 101, Freeman teaches that detergents and oils can be added. See column 7, line 58, through column 8, and line 9. Freeman is silent as to the amount of absorption of the superabsorbent particles as well as particle size.

Marciano-Agostinelli teaches a water migration resisting filler comprising a polymeric compound and particles of a water swellable material that is applied to stranded wires of cable, said particles having a particle size of less than 200 microns, per claims 94-95. See abstract and column 5, lines 51-53. The particles are of the type contemplated by applicants in claims 84-85 and 90-91, such as acrylamide and acrylate and have a water absorbing capability of 100 times its weight in water, as required by applicants in claims 82 and 88. See column 5, lines 43-62.

Though Freeman is silent as to the specific particle size of his particles, it is the examiner's position that changes in size are ordinarily not a matter of invention and that where the difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) and *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 220 USPQ 777 (Fed. Cir. 1984). In the instant case, the present claimed composition having superabsorbent particles of the requisite particle size would not perform differently than the prior art composition. In the alternative, Marciano-Agostinelli teaches the usage of superabsorbent particles having a particle size within the range contemplated by applicants. It would have been obvious to the skilled artisan at the time the invention was made to modify the teachings of Freeman by using superabsorbent particles having a particle size of less than 200 microns as taught by Marciano-Agostinelli and claimed by applicants, motivated by a reasonable expectation of success of obtaining a water migration resisting composition that can be applied to wire and cable and provide effective water blocking capabilities. As to the specific water absorbing properties of the superabsorbent particles, Marciano-Agostinelli teaches particles of the same type contemplated by applicants and as taught by Freeman. The skilled artisan would reasonably presume that the same particles necessarily have the same properties in the absence of factual evidence to the contrary.

Therefore, the combined teachings of Freeman and Marciano-Agostinelli would have rendered obvious the invention as claimed in the present claims.

Double Patenting

Applicant is advised that should claims 84 and 90 be found allowable, claims 85 and 91 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

No claims are allowed.

Response to Arguments

Applicant's arguments filed June 30, 2004 have been fully considered but they are not persuasive.

Applicants' request for Interference has been noted. However, applicants are reminded that before a claim (unless it is a patented claim) is considered as the basis for the count of an interference, the claim should be allowable and in good form. There has been no indication of allowable subject matter by the examiner. In addition, an interference exists between two applications or an application and a patent, if at least one claim from each would have anticipated or rendered obvious the subject matter of at least one claim of the other. The test is analogous to a statutory or obviousness type double patenting analysis. Note that the claims need not be identical in language or

scope for an interference to exist. See *Aelony v. Arni*, 547 F.2d 566, 192 USPQ 486 (CCPA 1977). There is no clear analysis on this record that at least one claim from the present application and the patent would have anticipated or rendered obvious the subject matter of at least one claim of the other.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

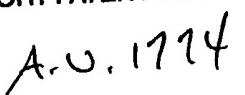
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-F 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jill M. Gray
Examiner
Art Unit 1774

jmg


RENA DYE
SUPERVISORY PATENT EXAMINER

A.U. 1774